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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/451,315	11/30/1999	DALE F. MCINTYRE	79909F-P	8863

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PATENT LEGAL STAFF
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EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 12/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/451,315

Applicant(s)

MCINTYRE ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the paper(s) filed 9/17/2002.

Specification

1. The abstract should focus on the elected software product/game, rather than the non-elected central host management of plural contest sponsors and their costs.

Claim Objections

2. Claim 17 is objected to because of the following informalities:
 - Claim 17 part c, the "to" after "forwarding" should be deleted for clarity.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 32-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 32 part b, forwarding a user to a remote site "so that said user can view a product advertisement" is unclear. It is uncertain if applicant is positively claiming a step of actually displaying the advertisement.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1, 7, 8, 12 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Small (US 5791991).

Regarding claims 1, 12, 16, Small teaches software for a consumer product promotion and game system where images are incorporated into a matching game.

The computer program that runs the game and the images used in the game are stored on a remote storage medium and when the program is loaded/run, the images are located and selected for loading so that the game can be played by the consumer PC client [col 2 line 59 to col 3 line 21]. The images are taken to be “supplied by the user” as it is the user that requests/supplies the images to the client PC/display from the remote storage medium, by way of playing/loading the game. Participation in the game or winning the game results in automatic display of a message(s) [col 7 lines 26-58].

Regarding claims 7, 8, a product coupon is sent by the system to the user PC for printing [col 7 lines 51-58].

Regarding claims 14 and 15, the Bingo game described by Small is taken to be a square section puzzle.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 10, 11, 13, (14, 15 alternatively), 17, 22, 23, 25-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Small.

Regarding claims 2, 10, 17, 22, 23, 25, 27, 31-34, Small teaches interaction between the user and remote computers to be via web sites over the Internet, including providing hot links to web sites of participating manufacturers [col 5 lines 14-27]. Small also teaches prompting the user to select products or product categories and sending the requested data such as rebate data to the user. Small also suggests manufacturers sponsoring games and displaying ads for the user. It would have been obvious to one of ordinary skill at the time of the invention to have accomplished such requested promotional/advertising information delivery by way of the hot links mentioned by Small so that users can easily request and obtain such rebate information at the end of the promotional games and can select/click to learn more about various products and browse the promoting manufacturer's web site(s).

Regarding claim 11, 26, the program and images required by the system of Small are inherently stored on some type of accessible media. It would have been obvious to one of ordinary skill at the time of the invention to have stored such on a hard drive computer disk for speedy access and retrieval of the data.

Regarding claims 13-15, 28-30, Small provides a matching game with images covering "hidden" tiles. The computer randomly selects product groups and checks to see if the user's selected hidden tiles match. If so, the hidden tiles are revealed. The computer uses images or a mosaic of images to provide the covering tile texture/surfaces. The game is Bingo, not concentration. However, Small teaches that other match games can be used instead [col 9 lines 12-15]. Official Notice is taken that the instantly described game of Concentration is a known game, where pairs of hidden cards/tiles are selected for matches to be revealed. It would have been obvious to one of ordinary skill at the time of the invention to have provided the promotional aspects of Small using the known game of Concentration rather than Bingo in order to provide a different game experience. Small provides a square section game/puzzle and it would have been obvious to one of ordinary skill at the time of the invention to have provided the known Concentration matrix as one which is square.

9. Claims 3-6 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Small in view of Walker et al (US6203427). Walker et al also teaches computer games. Each game/contest includes a gameID, customerID and winning information. The winning information is also encrypted [fig 11b, col 9 lines 1-25]. It would have been

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obvious to one of ordinary skill at the time of the invention to have provided such game/contest identification means so that a winner requesting the prize must verify the authenticity of the winning contest by any well known means such as by phone or computer, so as to eliminate fraudulent collection of prizes. It would have been obvious to one of ordinary skill at the time of the invention to have encrypted the contest and winning information to further secure against fraud.

10. Claims 9 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Small in view of Barnett et al (US6336099). Small does not take steps to prevent a user from printing multiple copies of coupons. Barnett et al also teaches electronic coupon distribution, but takes steps to ensure coupons can only be printed once [col 5 lines 47-62]. It would have been obvious to one of ordinary skill at the time of the invention to have prevented users from printing awarded coupons more than once, so as to eliminate fraud and to encourage playing multiple games, thus being subjected to more sponsorship promotion.

11. Claim 11 is alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Small in view of Forrest et al (US5679075). Forrest et al also teaches computer puzzle games. Forrest et al teaches that such puzzle games can be provided by a remote computer over the Internet, or alternately on CD ROMs distributed to playing users. It would have been obvious to one of ordinary skill at the time of the invention to

have provided Small's promotional gaming on distributed CD ROMS so that server resources can be reduced.

Response to Arguments

12. Applicant's arguments filed 9/17/2002 have been fully considered but they are not persuasive. Applicant argues that Small does not teach user-supplied images or personal images. As stated above, the user requests that the game be loaded for playing and the user is therefore responsible for supplying the images from the storage medium to the PC game program client.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc
November 27, 2002